

REMARKS

Claims 19-34 are pending. The remarks below address the restriction and election requirements.

Favorable and early action is respectfully solicited.

A. **Elections**

Applicants provisionally elect, with traverse,

Group I, drawn to a method of treating immunosuppression, encompassing claims 19-24.

With respect to the election of species, Applicants provisionally elect, with traverse,

alpha-glucosylrutin wherein hydroxycinnamic acid and/or cinnamic acid derivatives are optional.

B. **Arguments In Support of Withdrawal of the Election Requirements**

(1) **Restriction to Groups I-III**

(a) Examiner restricts Group I from Group III because the method of Group I allegedly does not encompass the compositions of Group III. Applicants respectfully disagree.

The PCT Administrative Guidelines at Annex B, page AI-57, provide examples illustrating the rules for whether or not claims to a method of use and a composition for that method may be examined in the same application. The following example is analogous to the situation presented by Groups I and III.

Example 4

Claim 1 Use of a family of compounds X as insecticides.

Claim 2 Compound X1 belonging to family X.
Provided X1 has the insecticidal activity and the special technical feature in claim 1 is the insecticidal use, unity is present.

In the PCT example shown above, the use of a family of compounds covers a method of using all members of the genus of compounds having the structure X. However, the composition claim is to a single species of X, namely X₁.

According to this example, Applicants' composition claims 30-34 would not be restricted, but would be examined with method claims 19-24. This would be true even if the composition claim, e.g., claim 30, recited only one of the flavonoids recited in the method claim 19.

Therefore, it is respectfully pointed out that Examiner's rationale for restricting Groups I and III directly conflicts with PCT unity of invention practice. Examiner's basis for the restriction is that because the composition claims do not encompass alpha-glucosylrutin, which is only one species of flavonoid, Groups I and III do not encompass the same or corresponding technical feature.

Respectfully, it would appear that the absence of single species as in Group III, or even all species but one as in the example, is not sufficient to obliterate the corresponding technical feature shared between a product and its method of use.

It is respectfully suggested that the restriction of Group I from Group III is traversed.

(b) The remarks stated above apply equally well to the restriction of Groups II from III, as the rationale is identical.

It is respectfully suggested that the restriction of Group II from Group III is traversed.

(c) Applicants also disagree that the methods comprising Group I and Group II should be restricted.

Examiner's rationale is that the two different methodologies have divergent clinical effects, end points and cellular processes. It is respectfully pointed out that these broad conclusory statements are not supported by any evidence of record. Further, it would appear that these conclusions are not likely to be correct.

Both methods are related by applying similar compositions to the skin as a means to prevent the damage of the immune system by UVB radiation. Thus, both methods would likely have similar clinical effects that are mediated by similar cellular processes. Therefore, the methods of Groups I and II clearly share a corresponding technical feature.

It is respectfully suggested that the restriction of Group I from Group II is traversed.

In conclusion, PCT unity of invention guidelines, require that all three groups be examined together.

(2) Election of Species

Applicants respectfully disagree with Examiner's conclusion that the species of flavonoids recited in the composition claims lack a general inventive concept as required by the PCT. With respect to Markush practice the PCT Guidelines state (emphases added);

f) "Markush Practice." The situation involving the so-called "Markush practice" wherein a single claim defines alternatives (chemical or non-chemical) is also governed by Rule 13.2. In this special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in Rule 13.2, shall be considered to be met when the alternatives are of a similar nature.

Having a similar nature is defined as having a common property and/or sharing a common structural element and/or being recognized in the art as being of the same class of compounds. PCT Adm. Instr., Annex B, page A1-54.

The Markush group of flavonoids satisfy all of these criteria.

Flavonoids are a class of polyphenolic compounds. The structural components common to these molecules include two benzene rings on either side of a 3-carbon ring (see figure below). Combinations of hydroxyl groups, sugars, oxygens, and methyl groups attached to these structures create the various flavonoids



In view of the fact that the flavonoids share a common structure and are recognized in the art as a common class of compounds, it is respectfully suggested that these compounds share a general inventive concept and special technical feature.

It is respectfully suggested that the requirement to elect a single flavonoid species is traversed.

C. General Comments

Applicants respectfully suggest that there is no proper basis to impose the restriction and election of species traversed herewith.

The present application was filed in 1997 and since that time, there have been no restriction/election requirements issued until the action dated May 19, 2002. During this seven years, there have been several examiners that have reviewed this application in detail. This

includes primary examiners, e.g., J. Venkat and yourself, supervisory examiner D. Dudash, and examiner Sharareh.

In fact, it is respectfully brought to Examiner's attention that since May 2002, Examiner himself has reviewed and approved two office actions, one of them a final action, as well as an advisory action without issuing any restrictions or election requirements. Therefore, the prosecution history of the application provides strong support for the existence of a prima facie case of unity of invention and that the outstanding restriction and election requirements should be withdrawn.

CONCLUSION

In view of the foregoing remarks, it is respectfully requested that all restriction and election requirements be withdrawn.

CONDITIONAL PETITION FOR EXTENSION OF TIME

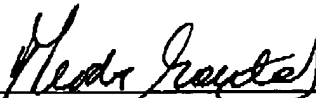
If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge the required fee to Deposit Account No. 14-1263.

ADDITIONAL FEES

Please charge any further insufficiency of fees, or credit any excess to Deposit Account No. 14-1263.

Respectfully Submitted,

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